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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,305	12/04/2003	Thomas Giroud	1948-4825	2184
27123	7590	12/12/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			KRUE, KEVIN R	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,305

Applicant(s)

GIROUD, THOMAS

Examiner

Kevin R. Kruer

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the After-Final Amendment filed November 23, 2005. Prosecution has been re-opened based upon the arguments presented in the response of November 23, 2005. Specifically, the rejection did not contain a motivation statement for combining the Applicant's admissions with the prior art.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on 12/5/2002. It is noted, however, that applicant has not filed a certified copy of the French application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 5, 11, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admissions in view of JP 2000-176659 (herein referred to as Hideji).

Applicant admits that motor manufactures very often require there to be particular motifs or patterns on lighting and indicating devices. The motifs are provided for aesthetic purposes and are obtained by deposition of inks or paint on the component to be decorated (see page 1 lines 10-22 of the specification).

Applicant does not admit that it is known to form the decorative motif on such components by metallizing said component and exposing at least one surface of the component to laser radiation. However, Hideji teaches a method of providing motifs to

a variety of transparent materials (005) by bonding a metallic foil (herein understood to read on "metallizing") and carrying out evaporation scattering of the metallic foil with a laser marker to obtain the desired motif (005). The laser utilized is preferably a YAG laser (0006). The metal layer may also be vacuum deposited (0010). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to decorate the lighting and indicating devices admitted to by applicant via the process taught in Hideji. The motivation for doing so would have been to provide said device with the desired aesthetic motif or pattern, as is desired in the art.

With regard to claims 2, 8, and 10, Applicant does not admit nor does Hideji teach that "a plurality of surfaces" may be exposed to laser radiation to produce the desired motif. Furthermore, Applicant does not admit nor does Hideji teach that the molded lighting and indicating device should be colored. However, Applicant admits that said motifs are provided for aesthetic purposes. The court has held that matter relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art (MPEP 2144.04). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to expose to laser radiation "a plurality of surfaces" of the molded lighting and indicating device taught by the prior art and to color said molded device. The motivation for doing so would have been to obtain the desired aesthetic effect.

5. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admissions in view of JP 2000-176659, as applied to claims 1, 2, 5, 11, 12, and 14 above, and further in view of Pyburn et al (US 5,614,338).

Applicant's admissions in view of JP2000-176659 is relied upon as above, but does not teach the surface of the polymer is modified with respect to color by exposure to laser radiation. However, Pyburn teaches a method of providing a graphic on a backlit component such as an illuminated display of an automobile wherein a molded plastic is exposed to laser energy to produce substantially opaque resins that form a graphic image (abstract). Said laser is produced by a suitable source such as Nd:YAG or carbon dioxide laser (col 2, lines 62+). Such a method eliminates the use of hazardous such as paints and inks (col 3, lines 19+). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create the patterns on lighting and indicating devices by exposing said molded plastic to laser radiation. The motivation for doing so would have been to eliminate the use of hazardous materials such as paints and inks.

Response to Arguments

Applicant's arguments filed November 23, 2005 have been fully considered but they are not persuasive.

Applicant presents two reasons for the claims being patentable over the prior art. First, the Office Action has failed to provide a proper rejection under 35 U.S.C.103(a). The rejection is considered improper because it fails to explain how one must modify either reference to arrive at Applicant's invention. Said argument has been fully considered and is persuasive. Prosecution has been reopened to address said error. The preceding rejections correct said deficiency and are proper under 35 U.S.C. 103(a).

Applicant further argues the claims are allowable over the applied art because the Office Action has improperly applied the standards set forth in MPEP 2144.04 in the rejection of Applicant's claims. Specifically, Applicant asserts that the limitations on the patentability of aesthetic design changes as set forth in MPEP 2144.04 apply only to composition and apparatus claims, and not to the steps of a method claim. If the examiner's logic was maintained, Applicant argues one would not be able to invent a new method of decorating a known object or material. The examiner respectfully disagrees. Initially, it is noted that counsel provides no evidence that the discussion in MPEP 2144.04 is only applicable to composition and apparatus claims. Furthermore, the examiner disagrees with counsel's conclusion that, if the examiner's position were to be maintained, one would not be able to invent a new method of decorating a known object or matter. Obviously, such a patent could be obtained if the claims are neither anticipated nor obvious over the prior art. In the present situation, the relevant question is whether it would have been obvious at the time the invention was made to take method taught in Hideji and utilize it on a plurality of surfaces of a formed component. The examiner maintains the position that the precedent discussed in MPEP 2144.04 clearly demonstrates it would have been obvious to do so in order to obtain the desired aesthetic characteristics.

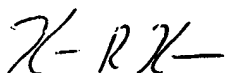
Applicant argues claim 4 is patentable because it depends from claim 1. Said argument is not convincing for the reasons noted above. Applicant's arguments with regards to claim 9 are considered moot since claim 9 has been deleted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773